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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,222	02/09/2001	Andrew M. Schwarzbauer	38916/24384	5359

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 08/29/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/780,222

Applicant(s)

SCHWARZBAUER ET AL.

Examiner

Mark T Henderson

Art Unit

3722

-- *Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4,6,8-14 and 24-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 3,4,6,8-14 and 24-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 6) ☐ Other: _____.

Art Unit: 3722

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Response to Amendment

1. After further consideration, the allowable subject matter stated in the last Office action has been withdrawn, and a new rejection has been given.

Art Unit: 3722

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the featured limitation of a “the base paper layer bottom surface within the periphery of the base paper layer”, as stated in Claim 10, line 9 and 10, and “wherein the breakaway layer is ...applied in a pattern” as stated in line 21 must be shown or canceled from the claim. Furthermore, in Claim 11, the limitation of “an area adjacent the periphery of the film layer receives a polymer..” must be shown or canceled from the claim

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 3722

3. Claims 11 and 30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification or drawings do not disclose “an area adjacent the periphery of the primary film layer receives a polymer..”.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10-12, 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not understood what is meant by “an adhesive layer wherein the base paper layer bottom surface within the periphery of the base paper layer is adhesively secured to the breakaway layer”. The examiner questions how “the base paper layer bottom surface” can be “within the periphery” of the “base paper layer”. In regards to Claim 10, 11, 24, 30, it is not understood what is meant by “an area furthest the periphery of the primary film” and “an area adjacent the periphery” in lines 21 and 22.

Art Unit: 3722

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 4, 6, 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (6,328,340).

Fischer discloses in Fig. 3a and 3b, a form with an integrated card comprising: a primary film (21) having top and bottom surfaces and a periphery; a breakaway layer (22) constructed of translucent urethane acrylic, and capable of accepting printed indicia (Col. 5, lines 20-25) and disposed between the primary layer (21, wherein the breakaway layer is adhesively coated on top) and a secondary layer (28); a die-cuts (31); and a base paper layer (1) having top and bottom surfaces; an adhesive layer (27) that secures the base paper layer (1) to the breakaway layer; and an information card comprised of the die-cut base paper (1), adhesive layer (27), and the breakaway layer (22); and wherein the breakaway layer has a greater affinity for the adhesive layer than the top surface of the primary film layer such that when the card is removed, the breakaway layer stays adhered to the bottom surface of the adhesive layer; and wherein the primary film layer

Art Unit: 3722

also has predetermined areas (area in which the information card is pulled upon) of greater and lesser affinity for the break away layer .

However, Fischer does not disclose: a breakaway layer composed of a material having a thickness that varies at different points along the primary film layer an applied in a pattern: a breakaway layer having release levels that vary in a predetermined pattern; a lower release level adjacent the periphery of the primary film layer.

In regards to **Claim 10**, it would have been an obvious matter of design choice to apply the breakaway layer in any desired pattern of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

In regards to **Claim 6**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the breakaway layer of any desirable material that varies in thickness at different points, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regards to **Claim 8, 13 and 14**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the die-cuts and area of greater affinity at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Art Unit: 3722

6. Claims 24-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steidinger et al (6,350,342).

Steidinger et al discloses in Fig. 4, a form with an integrated card comprising: a primary film (35) having top and bottom surfaces and a periphery; a breakaway layer (37) directly and removably bonded to the primary film layer (35); a secondary film layer (38) bonded directly to the breakaway layer (37); a die-cuts (33); and a base paper layer (31) adhesively bonded (adhesive 38) to the secondary film layer; and an information card consisting of the die-cut base paper (31), secondary film layer (38), and the breakaway layer (37); wherein the breakaway layer is removably bonded to the primary film layer and permanently bonded to the secondary film layer; and wherein the primary film layer also has predetermined areas (area in which the information card is pulled upon) of greater and lesser affinity for the break away layer.

However, Steidinger et al does not disclose: wherein the breakaway layer is composed of a material having a thickness that varies at different points along the primary film layer: a breakaway layer having release levels that vary in a predetermined pattern; a lower release level adjacent the periphery of the primary film layer.

In regards to **Claims 34**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the various release levels of the breakaway layer at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Art Unit: 3722

In regards to **Claim 38**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the breakaway layer of any desirable material that varies in thickness at different points, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regards to **Claim 32 and 33**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the die-cuts at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Normand et al discloses a form with an integrated card.

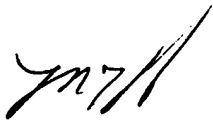
Art Unit: 3722

Response to Arguments

7. Applicant's arguments with respect to claims 3, 4, 6, 8-14, 24-38 have been considered but are moot in view of the new ground(s) of rejection.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

August 22, 2003



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